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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/672,425 | 09/26/2003 | Arthur Coello | 1.240.03 | 8437 |

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| EXAMINER | |
|---|---|
| EGWIM, KELECHI CHIDI | |
| ART UNIT | PAPER NUMBER |
| 1713 | |

DATE MAILED: 05/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/672,425 | COELLO ET AL. | |
| | Examiner | Art Unit | |
| | Dr. Kelechi C. Egwim | 1713 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *27 March 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-7 and 10-72* is/are pending in the application.

4a) Of the above claim(s) *12,13,52,53 and 55-72* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7,10,11,14-51 and 54* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election **without** traverse of Group I, species a, subspecies ii, claims 1-11, 14-51 and 54 in the reply filed on 3//27/06 is acknowledged.

2. Claims 12, 13, 52, 53 and 55-72 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no allowable generic or linking claim.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-7, 10, 11, 14-51 and 54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. The term "short chain" in claims 1, 22, 35 and 54, from at least one of which the balance of the claims depend, is a relative term that renders the claims indefinite. The term "short chain" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention. The original disclosure does

not provide a proper definitive definition of how "short" the polymer chain must be to meet the "short chain" limitation used in the claims. Thus, the requisite molecular weight is indefinite.

### *Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1-7, 10, 11, 14-51 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz, Jamasbi or Suk, for reasons cited in the First Office action.

Although Swartz, Jamasbi or Suk do not disclosure conventional aerosol paint additives such as a bactericide, a light stabilizer, the specific fillers claimed and polyvinyl acetate as the polymeric resin, it would have been obvious to one having ordinary skill in the art, at the time the invention was made, to include these conventional additives to the aerosol paint compositions. The applicant has still not shown unexpected results from including these additives in the aqueous aerosol paint compositions.

Further, regarding the filtered water, a pure composition is unpatentable over an impure one if the utility is the same (See In re Crosley 72 USPQ 499 and In re Merz 1938 CD 728).

***Response to Arguments***

8. Applicant's arguments filed 03/27/2006 have been fully considered but they are not persuasive.

9. Firstly, regarding the argument that the so called "high molecular weight polymers and copolymers" of the prior art are in contrast with applicant's polymer, as stated above, applicant has not defined the "short chain" to correspond to any actual MW's. The "Mowilith D-50" recited in the argument is not defined in the specification in a way as to properly define the "leaps and bonds" of "short chain" as used in the present claims. Further, a trade name like "Mowilith D-50" cannot be used to define a particular material or product in compliance with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). A trademark or trade name is used to identify a source of goods, and **not the goods themselves**.

10. Secondly, with regard to the alleged "elevated glass transition temperatures" in the prior art, it is noted that this feature upon which applicant relies is not recited in the rejected claim(s). Even if properly defined in the specification, which, incidentally, it is not, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

11. Regarding the argument that "[a]pplicants' present inventive composition is further formulated to minimize or eliminate volatile organic components, including many

the water-soluble organic solvents and other components disclosed in the Swartz, Jamasbi, and Suk patents", applicant is pointed to their own specification which, on page 11, recites:

> "In at least one embodiment of the present invention the aqueous solvent may comprise an amount of water, however, it is understood that other aqueous solvents may be utilized and that compositions comprising such other aqueous solvents are also included within the scope and intent of the present invention."

Thus, even if required by the prior art, such aqueous/water-soluble solvents would not be prohibited for the present invention.

12. Regarding the argument that "the aqueous paint component [is] formulated to substantially degrade within four weeks of application," the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

13. Finally, regarding the declaration, applicant's declaration only confirms that one of ordinary skill in the art would have found it obvious to determine a workable or even optimum range of the additive component (i.e., pigment, filler, etc.) to obtain the desires results. "[D]iscovery of an optimum value of a result effective variable in a known process is ordinarily within the skill of the art." In re Boesch, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980); "[W]here the general conditions of a claim are disclosed

in the art, it is **not** inventive to discover the optimum or workable ranges by routine experimentation. In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (571) 272-1099. The examiner can normally be reached on M-T (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KCE

KELECHI C. EGWIM PH.D.
PRIMARY EXAMINER